

REMARKS

Overview

Claims 1-40 are pending in the present application. All the claims remain rejected on a variety of grounds. This response is an earnest attempt to advance prosecution of this application and address the issues raised by the Examiner's action. Reconsideration is respectfully requested.

35 U.S.C. § 101 Rejection

Claims 15-20, 35 and 40 stand rejected under 35 U.S. C. § 101 as being nonstatutory. This rejection is respectfully traversed. In Applicant's prior response, specific language was added to the independent claims to try to solve this issue. For example, "an information processing device" has been added to those claims. To further the application, the "information processing device", and its interaction with limitations in each of the independent claims, has been further emphasized. Therefore, each independent claim specifically recites a device. It specifically recites the interaction of the limitations of the claim with the device. Under controlling law, it is respectfully submitted the claims are clearly statutory.

If the Examiner believes some additional language is required, Applicant respectfully requests a suggestion of the same as Applicant earnestly submits that this issue should be able to be resolved and wishes to work with the Examiner to do so. The Applicant respectfully points out that claim language in the principal cited references Hatakama and Cook uses similar terminology as used in Applicant's claims.

Claim Objections (Action Page 4, Numbered Paragraphs 8-13)

The claims have been revised in a manner which is submitted to resolve any claim 1 objection of the Examiner under this objection to the claims. The intent of the claims was to present parallel sets of depending claims to each independent claim. For example, new dependent claim 40 adds similar limitations to independent claim 16, as claim 21 does and claim 28 does to claim 1. The amendment presented herein to the dependent claims is submitted to resolve the stated objections in the Action.

35 U.S.C. § 112 Rejections

Claims 22-25, 31-32, 36-37 and 39 stand rejected under 35 U.S.C. § 112, second paragraph. It is respectfully submitted that the amendments made to the claims resolve the issues raised under this rejection.

35 U.S.C. § 102 Rejections

Claims 1-4, 9-11, 14, 24, 31 and 38 stand rejected under 35 U.S.C. § 102(e) as anticipated by Hatakama, U.S. Patent No. 5,774,118 ("Hatakama"). This rejection is respectfully traversed.

Hatakama has been discussed in Applicant's prior responses. It is respectfully submitted that Hatakama is not available as legal prior art to the present invention for the reasons previously made of record, which are incorporated by reference herein.

To reiterate, however, it is respectfully submitted Hatakama has clearly been antedated by the evidence of record. It is respectfully submitted, therefore, that a *prima facie* case of anticipation has not been shown between the disclosure of Hatakama and Applicant's claims.

It is understood that the present Office Action takes the position that conception evidence of record, at best, establishes only "a vague idea". See Action, pages 2-3.

It is respectfully submitted that starting point for evaluating this issue is the claim language itself. Applicant's claim 1 is reproduced below in table format. The limitations of claim 1 are set forth on the left side. On the right side are examples of specification support for each limitation.

Claim 1	Specification Support
A method of providing instruction to a user of an instructional program comprising:	Entire Specification
presenting an interactive instructional program to the user via an information processing device, the program having a plurality of sections each comprising instructional information related to a subject;	Pages 1-3
making available to the user via the information processing device additional instructional options related to the instructional information for one or more sections in the program;	Figures 1-3
the additional instructional options for said one or more sections including additional instructional information available to the user via the information processing device in at least first and second levels of sophistication, any of the at least first and second levels of sophistication being user-selectable via the information processing device, at any time and in any order.	Figures 2-5 and associated description in the written specification. (See Figure 4 for first level and Figure 5 for second level).

The focus of claim 1 is precisely what is shown in Figures 2 and 3. Unlike conventional instructional programs which present information to be learned to the user in one format, claim 1 specifically requires that the user have available to him/her, at any time of their choosing, essentially two different virtual tutors. Depending on choice of the user, the user can select one tutor if they feel it would help the user learn better or are more comfortable with the teaching or assistance approach of that tutor, or can select the other one. This is the choice between two levels of sophistication. The specification, e.g., pages 17-23, gives a variety of examples of different levels of sophistication. The example most prominently discussed is tutorial assistant which has a first level that is basic or plain or at a "lower level of sophistication". A second level is enhanced or more complex, or more formal or academic, and thus a second or "higher" level of sophistication. It is like having the ability to either request (a) help from a peer or (b) help from a professor -- both immediately available to the user at their selection. The user can always invoke one tutor. Alternatively, the user can sometimes invoke one for some information and then the other for other information. Or, the user could invoke one and then turn to the other one for the same piece of information to be learned to get two different views of that material.

Figure 1 of the application illustrates the invention can be practiced in a computerized form. Interactivity can be through a keyboard, mouse and display. The program can be embodied on media such as a CD ROM (see Figure 1) and compare it to the preamble and first sub-paragraph of Applicant's claim 1 (see chart above).

Figure 2 is a flow chart of the methodology according to Applicant's claim 1. The information to be learned, the "context", the "information" itself, and optionally even questions and answers related to the information, can be presented to the user to help them learn the information. But whatever mode is presented to the user, the user has the ability to call out for

additional instructional options for either (a) the "huh or plain" first level of sophistication virtual tutor, or (b) the "tell me more or enhance" second level of sophistication virtual tutor. Figure 2 specifically shows, in flow chart or algorithm form, how the user can select for either of the two levels of sophistication tutorial assistance (the "first and second levels" of "additional instructional options" of Applicant's claim 1, 2nd and 3rd sub-paragraphs). Accompanying description in Applicant's written specification describes same.

Figure 3 provides a specific example of information to be learned (left-hand side) and the immediate selectable availability of either (a) "huh?" or (b) "tell me more" additional instructional options. Figure 4 gives a specific example of "huh?". Figure 5 gives a specific example of "tell me more". The written description at pages 17-23 gives specific examples of the "huh?" first level of sophistication and "tell me more" second level of sophistication.

One example given in the specification is literally that the first virtual tutor for "huh?" is a grumpy, plain speaking person and the "tell me more" is professorial. Thus, the labeling and distinction between (a) "huh?" or plain-spoken, and (b) "tell me more" or enhanced.

With this in mind, the issue is whether the evidence of record provides sufficient showing of conception of claim 1 prior to the earliest effective date of Hatakama or Cook, Patent No. 5,727,950 ("Cook"). Below is a timeline chart that will be referred to hereafter:

Dates	Applicant Events	Hatakama Events	Cook Events
January 1995 and earlier	Figure 2 created and presented in tangible form		
March 1995	Demonstration CD of interactive computerized program that includes both "huh?" and "tell me more/enhance" features of Figures 2-5 created.		
August 22, 1995		U.S. filing date	
May 22, 1996			U.S. filing date
Oct. 25, 1996	U.S. filing date		

As stated in Applicant's prior response, Applicant's burden is only to show through, other than Applicant's own testimony, corroborating factual evidence of conception prior to the U.S. filings dates of Hatakama and Cook. It is respectfully pointed out this is clearly shown at least by the following:

1. The conception flow chart of January 1995, which matches Figure 2 of Applicant's application and disclose the material limitations of Applicant's claim 1, has been shown to be in existence and in tangible form prior to the legal prior art dates of Hatakama and Cook.
2. Actual CD ROMs with software programming that could be and was demonstrated on computer systems in early 1995, which matches Figures 1-5 of Applicant's specification and includes the material limitations of Applicant's claim 1 has been shown to be in existence and in tangible form, again well before the legal prior art date of either Hatakama or Cook. (See original Exhibit E and concurrently filed substitute Exhibit E).

The evidence previously of record not only provided factual corroboration by tangible factual evidence by virtue of the above described items, but additional evidence also has added to that existing evidence, e.g., by providing specific screen displays from the physical, in existence, CD of Exhibit E including a content listing bearing 1994 and early 1995 creation dates (Exhibits F and G), a screen print showing it to be an interactive customer assistance program (Exhibit H), a specific screen display showing the "huh?" and "tell me more" two levels of sophistication learning assistance options (Exhibit I), a specific example of the "huh?" or plain or simple first level of sophistication for a specific piece of information to be learned (Exhibit J), and a "tell me more" or enhanced learning assistant option (Exhibit K).

Thus, the record has established the existence of physical, tangible, reduced-to-practice prototypes of Applicant's claim 1. Referring back to the claim 1 chart above, the CD is an instructional program (claim 1 preamble), it is embodied in an interactive instructional program that can be implemented via an information processing device (sub-paragraph 1 of claim 1), and which has a plurality of sections, each comprising instructional information related to a subject (claim 1, sub-paragraph 1). It establishes corroboration of additional instructional options for one or more sections of the program (claim 1, second sub-paragraph). And, it explicitly establishes the existence of first and second levels of sophistication additional instructional options which are user selectable in the use of the instructional program (claim 1, last sub-paragraph). Exhibit E is a CD ROM with the program of claim 1 on it. Exhibits F and G demonstrates specific examples of the content on the CD ROM. Exhibit H shows that it is an interactive learning program. Exhibit I shows the ability to select between optional learning assistance selections of two levels of sophistication "huh?" and "tell me more", and Exhibits J and K show specific examples of first and second levels of learning assistance options respectively.

In summary, Applicant's claim 1 has been shown, by corroborating tangible evidence over and above the Applicant's own testimony, the existence of a method, apparatus, and system which is identical to what is claimed and disclosed in Applicant's application. As such, conception is clearly established prior to any legal prior art data of Hatakama or Cook. On these grounds alone, it is respectfully submitted these two references are antedated and are not legal prior art against Applicant's claims.

A similar analysis applies to Applicant's independent claims 11 and 16 and all dependent claims.

35 U.S.C. § 102 Rejection

Claims 1-4, 9-11, 14, 24, 31 and 38 stand rejected as being anticipated under 35 U.S.C. § 102 on the basis of Hatakama. This rejection is respectfully traversed.

For the reasons set forth above, Hatakama has been shown to not be legal prior art relative to Applicant's claims. Therefore it cannot present a *prima facie* case of anticipation.

35 U.S.C. § 103 Rejections

Claims 5-8, 12-13, 15-20, 35 and 40 stands rejected as being obvious in light of Hatakama in view of Cook. This rejection is respectfully traversed.

For the reasons set forth above, both Hatakama and Cook have been antedated and therefore neither of these are legal prior art relative to Applicant's claims; and neither individually or in combination can present a *prima facie* case of obviousness against these claims.

Claims 21-23, 25 and 36-39 stand rejected as obvious on the basis of Hatakama. This rejection is respectfully traversed.

Hatakama has been antedated and therefore cannot be legal prior art nor present a *prima facie* case of obviousness relative to these claims.

Applicant respectfully submits the evidence of record supports Applicant's positions. However, to advance prosecution of the present application, Applicant stands willing to produce for the Examiner a CD referenced in the evidence and show the Examiner its operation, if the Examiner feels that it is necessary.

Conclusion

It is respectfully submitted all matters raised in the Office Action have been addressed and remedied and that the Application is in form for allowance. Favorable action is respectfully requested.

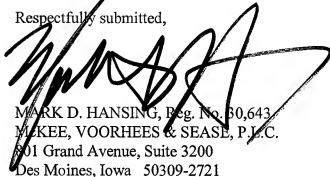
This also is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for one month from December 8, 2006 to January 8, 2007. Applicant is a small entity; therefore, the fee is \$60.00.

Please also charge Deposit Account No. 26-0084 the amount of \$25.00 for one new additional claim over 20.

No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



MARK D. HANSING, Reg. No. 30,643
MCKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885
Attorneys of Record

- bjh -